



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/587,090	10/14/2007	Octavian Schatz	MS143PCTUS	7674
81777	7590	07/14/2011	EXAMINER	
MorphoSys AG Lena-Christ-Str. 48 Martinsried/Planegg, 82152 GERMANY			CHUNDURU, SURYAPRABHA	
			ART UNIT	PAPER NUMBER
			1637	
			NOTIFICATION DATE	DELIVERY MODE
			07/14/2011	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

ipmailbox@morphosys.com  
paul.wiegel@morphosys.com

<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	Application No. 10/587,090	Applicant(s) SCHATZ ET AL.
	Examiner PRABHA CHUNDURU	Art Unit 1637

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 28 June 2011 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☒ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on \_\_\_\_\_. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

#### AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: none.  
Claim(s) objected to: none.  
Claim(s) rejected: 1-13.  
Claim(s) withdrawn from consideration: none.

#### AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

#### REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_  
13. ☐ Other: \_\_\_\_\_.

/Suryaprabha Chunduru/  
Primary Examiner, Art Unit 1637

Continuation of 11. does NOT place the application in condition for allowance because: the Applicants' arguments drawn to the rejection of claims 1-13 under 102(b) as being anticipated by Lexow et al. were found unpersuasive for the following reasons. First, Lexow et al. teach target nucleic acid fragments ligated to adapter overhangs and the ligated product reads on elongated fragment. The broader scope of the claims do not exclude ligated product as an elongated fragment. Second, Lexow et al. teach releasing overhang-adaptor ligated target nucleic acid (ligated or elongated fragment) from the solid support with restriction enzymes, specifically type IIS restriction enzymes which cut the DNA away from the recognition site producing one longer fragment and one shorter fragment, which clearly teach that the elongated fragment is digested to form unequal fragment sizes with the use of type IIS restriction enzymes (see at least page 8, line 37-38, page 9, line 1-10, page 11, line 21-36). Third, with regard to arguments drawn to referring specific portions of the instant specification, it is noted that according to MPEP 2145 Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). Fourth, with regard to the arguments drawn to no teaching of modification, it is noted that on page 9, line 10-38, page 10, line 1-30 clearly teach that the ligated fragments comprise binding moiety to enable attachment to a solid support. Fifth, with regard to the arguments drawn to preamble, the arguments were found unpersuasive because MPEP 2111.02 notes, "If the body of a claim fully and intrinsically sets forth all of the limitations of the claimed invention, and the preamble merely states, for example, the purpose or intended use of the invention, rather than any distinct definition of any of the claimed invention's limitations, then the preamble is not considered a limitation and is of no significance to claim construction." This limitation in the preamble of the claim is not given patentable weight. The final step of the claim 1 do not correlate back to the preamble thus the limitations in the preamble are not given any patentable weight. Accordingly the rejection is maintained.

With regard to the rejection of claims 1-13 (inadvertently referred as 13-21) under 35 USC 102(e) as being anticipated by US20060194202, the arguments were found unpersuasive because the instant claim 1, step c) recites 'wherein the modification of the first ligation product essentially corresponds to the second the second single-strand overhang' which do not necessarily read on a modification as a second single-strand overhang as asserted, rather it could be a streptavidin that corresponds to a biotin thereby forming a binding pair. Accordingly biotin modification is within the scope of the claims. In addition, the instant dependent claims 9-11 recite such modification is biotin and the interacting group is a streptavidin. Accordingly the rejection is maintained.